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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,256	12/04/2003	Stefan Gotzfried	DT-6704	7786

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EXAMINER

WILLIAMS, JAMILA O

ART UNIT	PAPER NUMBER
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3722

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

ED

Office Action Summary	Application No. 10/728,256	Applicant(s) GOTZFRIED, STEFAN	
	Examiner Jamila Williams	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The amendment filed 11/10/2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The amended language on pages 6-7 of the specification ("The groove is closed at its drill side end and opens at the drill end surface...") was not supported by the original disclosure and therefore constitutes new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1,3-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The recitation of "the at least on flushing liquid conduit is formed as a groove in the inner surface closed at a working tool side thereof

for introducing flushing liquid into the percussion working tool through an opening formed in an end surface thereof", was not supported by the specification as originally filed and therefore constitutes new matter. It is noted that applicant has support for having a flushing liquid conduit formed as a groove and introducing the flushing liquid into an opening in the end surface thereof (page 6 last sentence which carries over onto page 7 of the original specification and element 6 of the figures) but having a groove in the inner surface closed at a working tool side is not supported. From the figures it also appears that the groove 6 is contiguous with the opening or inner surface of the chuck.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1,3-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what is encompassed by the phrase "the at least on flushing liquid conduit is formed as a groove in the inner surface closed at a working tool side thereof..."

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,3,4 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by 3,215,443 to Irving in view of 5,378,091 to Nakamura. Irving discloses a pot shaped

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chuck (1) designed to cooperate with a percussion mechanism (20) of a percussion power tool (fig 1) and an empty space of which is open at a working tool side thereof for receiving a working percussion tool (column 2 lines 46-50) and an empty space of which is open at a working tool side thereof for receiving a working percussion tool (5), the chuck comprising guide means (collet 12 or bushing 24) coaxial with a percussion axis and in which the working percussion tool (5) is received for joint rotation with the chuck and limited axial displacement thereto, at least one flushing liquid conduit extending along an inner surface (2) forming the pot empty space (looking at figure 2, the space between the tool 5 and the inner circumference of the chuck 1 forms the fluid conduit, in that the tool is hexagon and the inner circumference of the chuck is circular there is a space between the two).

Irving does not however disclose the at least one flushing liquid conduit being formed as a groove in the inner surface closed at a working tool side thereof for introducing flushing liquid into the percussion working tool through an opening formed in an end surface thereof. Nakamura teaches (fig 7a,b) having grooves (24) in the chuck body for liquid. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the grooves of Nakamura with the pot shaped chuck of Irving for the purpose of providing better fluid flow through the opening of the tool.

Regarding the limitation of the groove in the inner surface being closed at a working tool side (as best understood in light of the 112 rejections above, the examiner takes the position that Irving modified by Nakamura provides this feature).

Regarding claim 3, Irving modified by Nakamura discloses a flushing head (16 of Irving) arranged radially outwardly rotation free and liquid-tightly (via rings 28,29 of Irving) in axial region of the pot wall; and at least one cross bore (18 of Irving) formed in the pot wall for communicating the flushing head with the flushing liquid conduit.

Regarding claim 4, Irving modified by Nakamura discloses entraining webs (interior surface of the collet 12 of Irving) extending along the guide means and forming entraining means for receiving a shank of the working percussion tool and transmitting a torque to the working percussion tool (column 3 lines 4-14 of Irving).

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Irving in view of Nakamura and further in view of 2,827,019 to Taylor. Irving modified by Nakamura discloses all elements of the claims but for the chuck having inner threads extending along the guide means and cooperating with an outer thread provided on the shank of the tool. Taylor teaches having a chuck with interior threads (23) and a tool (25) having an exterior thread (24). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the thread teaching of Taylor with the chuck and tool of Irving modified by Nakamura for the purpose of providing a better connection between the chuck and tool.

Response to Arguments

Applicant's arguments filed 11/10/2006 have been fully considered but they are not persuasive. The limitations added to both the specification and claims constitute

new matter. It is noted that applicant has commented that the amendment to the specification does not constitute new matter since the limitation is shown in the drawings. However it does not appear that the specification (including the drawings) has support for having "a groove in the inner surface closed at a working tool side thereof...". The drawings appear to show the groove contiguous with the opening or inner surface of the chuck.

Conclusion

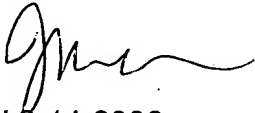
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamila Williams whose telephone number is 571-272-4431. The examiner can normally be reached on Monday-Thursday 6:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JW 2-14-2006



MONICA CARTER
SUPERVISORY PATENT EXAMINER